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Charles W. Stewart  
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Date: 7 January 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re application of	)	
	)	
NICHOLAS J. ADAMS	)	
	)	
Serial No. 10/797,223	)	Group Art Unit: 1764
	)	
Filed March 10, 2004	)	Examiner: Prem C. Singh
	)	
PROCESS FOR PREPARING A	)	September 18, 2007
LUBRICATING BASE OIL AND A GAS OIL	)	
_____	)	

COMMISSIONER FOR PATENTS  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF**

This brief is filed in reply to the Examiner's Answer mailed November 9, 2007. It is respectfully requested that the Board reverse the final rejection of claims 1-9 of the above-identified application for the reasons discussed below as well as those presented in Appeal Brief filed September 20, 2007.

### **Reply to Arguments Made in Examiner's Answer**

On page 6 of the Examiner's answer, although not disputing the fact Van Ballegoy et al makes absolutely no mention of gas oil, the Examiner states that: "Clearly, Van Ballegoy produces lubricating base oils, and in addition, other fractions including gas oil." Appellant submits nothing could be less clear.

The sole basis for the Examiner's statement appears to be the disclosure on page 17 of Van Ballegoy et al, lines 6-21 which reads: "The effluent from the catalytic dewaxing process or optionally the effluent of a hydrofinishing treatment applied subsequently is separated into a gaseous fraction and a liquid fraction. Such separation or fractionation can be attained by conventional methods, such as by distillation under atmospheric or reduced pressure. Of these, distillation under reduced pressure, including vacuum flashing and vacuum distillation, is most suitably applied. The cut point(s) of the distillate fraction(s) is/are selected such that each product distillate recovered has the desired properties for its envisaged application. For lubricating base oils the cut point will normally be at least 280°C and will normally not exceed 400°C, the exact cut point being determined by the desired product properties, such as volatility, viscosity, viscosity index, and pour point."

While this disclosure suggests that other fractions (in addition to the desired lubricating base oil product) may be obtained, there is no disclosure as to which specific additional fractions may be obtained or how much of each fraction may be obtained. The product obtained in each of the examples in Ballegoy et al is a lubricating base oil product. There is absolutely no indication in Ballegoy et al that a gas oil product is produced or desired, and certainly no teaching of producing a gas oil product in a yield which is larger than the fraction boiling below the gas oil fraction.

The Examiner's speculation that one of the "other fractions" may be a gas oil is not based on the teachings of the reference itself, which makes no mention of gas oils, but appears to be based on the teachings in Appellant's own application, which it is inappropriate for the Examiner to use for the rejection.

The Examiner repeats the unsupported assertion that Van Ballegoy et al produces lubricating oils and also other fractions, "including gas oil" on pages 7, 8 and 10 of the Examiner's answer. Repeating an incorrect and unsupported statement a number of times

does not improve its credibility. There is absolutely no disclosure in Van Ballegoy et al that gas oil is ever produced, or that a gas oil product is desired, and there is certainly no basis to assert that the “other fractions” in Van Ballegoy et al include a gas oil product in a yield which larger than the fraction boiling below the gas oil fraction. The only teachings regarding the production gas oil products, or yields of gas oil products greater than the fraction boiling below the gas oil fraction, is found in Appellant’s application, which the Examiner is not permitted to use as a basis for the rejection.

That the Examiner is relying on Appellant’s own teachings for the rejection is clear from several statements made on page 8 of the Examiner’s Answer. The Examiner acknowledges that “The tables (in Van Ballegoy) do not show gas oil yield.” But notes that “Ballegoy discloses that other gas and liquid products are produced” and goes on to speculate that those “other products” include a gas oil yield because “It is noted that the Appellant’s Table 2 (Specification: Table 2, page 13) shows major production (62.8 wt%) of lubricating base oil and minor production (20.9 wt%) of gas oil.” The fact that the Examiner must refer to Appellant’s application for a teaching of gas oils, makes it clear that the Examiner is using Appellant’s own teachings as a basis for the rejection. There, simply is no teaching in the reference that the “other fractions” include a gas oil. This is either pure conjecture on the Examiner’s part, or conjectured based on knowledge he acquired from Appellant’s application.

A further and even more extreme example of speculation by the Examiner regarding the Van Ballegoy et al reference is found on page 11 of the Examiner’s Answer. In the Appeal Brief Appellant argued that based on the cutting temperature of 390 °C used in Example 12 of Van Ballegoy et al, it is clear that the product produced in this example is a lubricating base oil, with a 1.1 wt% gas make, and that there is no disclosure of other fractions, and certainly disclosure of a gas oil product being produced in this example. In response the Examiner refers to Table X of Van Ballegoy et al which presents the results of Example 12, and shows a lubricating base oil yield of 48.1 wt% and gas make of 1.1 wt%, and does not show any other products, which seems to support Appellant’s argument.

Nevertheless, in his answer the Examiner states “The table shows lubricating base oil yield of 48.1 wt% and gas 1.1 wt% (total being 49.2 wt%). The Examiner goes on to

speculate that "One skilled in the art will simply ask, where is the balance (50.8 wt%)? Clearly Ballegoy is producing 50.8 wt% of other fractions including gas oil".

The Examiner's speculation about the "50.8 wt % balance" is wrong for at least two reasons. The first reason is that the term "yield" refers to the amount of raw material (in the case of Example 12, the wax-containing feedstock) that is converted into the desired product. Thus, a lubricating base oil yield of 48.1 wt% simply means that 48.1 wt% of the feedstock was converted into the desired lubricating base oil with a 1.1 wt % gas make. The other 50.8 wt% of the feedstock may not have been converted at all. Therefore, one skilled in the art can not tell from the disclosure in Table X whether any other fractions were produced. It is possible that the 48.1 wt% lubricating base oil and the 1.1 wt% gas make represents the total amount of the feedstock that was converted.

The second reason is that even if more than 48.1 wt% plus 1.1 wt% of the feedstock was converted into other fractions, one skilled in the art would still not know from Van Ballegoy et al what type of other fractions were produced, or what amounts of other fractions were produced, because the reference is silent in this regard.

Therefore, the statement one page 11 of the Examiner's Answer that "Clearly, Ballegoy is producing 50.8 wt% of other fractions including gas oil" is incorrect and unsupported by the teachings of the reference.

## **CONCLUSION**

For all the above reasons, as well as those presented in the Appeal Brief, claims 1-9 of the present application are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the action of the Examiner in finally rejecting these claims, be reversed, and that the application be passed to issue.

Respectfully submitted,

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By



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